

REMARKS/ARGUMENTS

In the Election/Restriction requirement dated June 13, 2008, the Examiner delineated the following inventions as being patentably distinct.

Group I: Claims 1-14, drawn to compounds of formula I.

Group II: Claims 15-17 and 19-20, drawn to a method for preparing compounds of formula I.

The Examiner further required the election of a single species.

Accordingly, Applicants provisionally elect with traverse Group I, Claims 1-14 drawn to compounds of formula (I) and the species (2Z)-(1-ethyl-1,3-dihydro-2H-benzimidazol-2-ylidene)(5-methyl-2-{[3-(2-oxopyrrolidin-1-yl)propyl]amino}pyrimidin-4-yl)acetonitrile (Example 4, page 52 of the international application).

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. §803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinction.

All of the claims are linked with respect to same utility, benzimidazole acetonitrile containing pharmaceutical compound that is responsible for the activity in the treatment of metabolic disorders mediated by insulin resistance or hyperglycemia comprising diabetes type II, inadequate glucose tolerance, and insulin resistance obesity.

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. There is a commonality that exists between the groups. It is a technical relationship that involves the same feature, and it is this technical feature that defines the contribution which each of the groups taken as a whole make over the prior art.

Restriction between a chemical product and a process for its production is only proper when the product can be made by another method. Compound and method for making are interdependent and should be examined together on the merits.

Unity of invention has to be considered in the first place only in relation to the independent claim. A dependent claim is one which contains all the features of another claim and is in the same category of claims as the other claims. It does not matter if a dependent claim itself contains a further invention.

In chemical cases a specified group of material which do not necessarily belong to an otherwise class and cannot be defined by generic language but which nevertheless have a community of chemical or physical characteristics can be claimed together. The members need only possess at least one property in common which is responsible for the function of the claimed relationship. The same utility in a generic sense suffices.

Further, the M.P.E.P. §803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits even though it includes claims to distinct and independent inventions.

Applicants submit that a search of all the claims would not constitute a serious burden on the Office.

Applicants request that should the elected species be found allowable, the Examiner expand the search to include the non-elected inventions.

Divisional applications filed thereafter claiming the non-elected invention should not be subject to double patenting ground of rejection, 35 U.S.C. §121, In re Joyce (Commr. Pat. 1957, USPQ 412).

Applicants submit that the above identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.

Respectfully submitted,

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